



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,720	12/11/2001	Ari Shaer	107.103	4119
22846 7590 04/13/2009 BRIAN ROFFE, ESQ 11 SUNRISE PLAZA, SUITE 303 VALLEY STREAM, NY 11580-6111				
EXAMINER				
LEVINE, ADAM L				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
04/13/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/014,720

Applicant(s)

SHAER, ARI

Examiner

ADAM LEVINE

Art Unit

3625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
b) ☒ They raise the issue of new matter (see NOTE below);
c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 9-12 and 21.
Claim(s) withdrawn from consideration: 1-6, 8 and 22-29.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art Unit 3625

Continuation of 11, does NOT place the application in condition for allowance because: Applicant has misunderstood or mischaracterized the substance of the interview of January 8, 2009. The examiner explained that the basis for the restriction by original presentation was the change in the control over payments in claim 1 so that the payments first fell directly under the control of the organizer. The organizer would then direct the provider to forward the purchased item to the organizer. This is a significant change from the previously examined claims, represented by claim 9. In claim 9, the control over funds was interpreted as falling first to the provider, who would then be contractually obligated to deliver the goods and generate benefit for the organizer based on the obligation. As explained by the examiner, because claim 9 was significantly broader than than claim 1, it was the only of the two independent claims that could possibly still be interpreted as being directed to the original invention. This was so because "upon acceptance by a provider of the selected one or more of the goods and services to the manner of payment associated with the goods and services by the consumers other than organizer" was interpreted as meaning the provider accepted payment, and therefore that control over the funds went through the provider. In light of the after final amendments, this interpretation would no longer be possible and both independent claims would now be directed to a different invention than that originally filed. They are however both now directed to the same invention.

It is here noted with regard to the amendment of claim 9 that the flow of the payment by the consumer has been switched from the provider to the organizer but acceptance of the manner of payment still lies with the provider. This may not be exactly what applicant intended and it raises other issues in addition to the above. First, it raises the new matter issue because the previous interpretation of "acceptance by a provider... to the manner of payment," is no longer possible. This phrase was previously interpreted as acceptance of payment by the provider. The new claim language maintains "acceptance... to the manner of payment," with the provider, but the actual payment is made to the organizer. This was not disclosed in the specification. It also raises a clarity issue under 35 USC 112, second paragraph, because it is unclear what exactly applicant intends to claim with this language, especially since the specification as filed provided no further explanation. Finally, the meaning of "generating benefit for the organizer based on the contractual obligation, the generated benefit being a difference between the first and second prices," is also unclear because given the previously described flow of payment, this phrase appears to suggest a benefit to the organizer equal to the difference between the first and second price, in addition to an equal benefit that would already have flowed to the organizer as a result of the initial flow of funds through the organizer. Is it applicant's intention to provide this double benefit to the organizer?